

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte C. DOUGLASS THOMAS

Appeal No. 2003-0238
Application No. 08/886,349

HEARD: November 18, 2003

Before HAIRSTON, BARRETT, and GROSS, ***Administrative Patent Judges.***
GROSS, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 23 and 25 through 51, which are all of the claims pending in this application.

Appellant's invention relates to a computer implemented method for performing a survey. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A computer implemented method for performing a survey, comprising:

(a) registering participants over a network to form a database of registered survey participants, said registering (a) being performed by participants completing an on-line registration form;

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(b)receiving a survey in an electronic format at a central server, the survey having survey questions;

(c)automatically selecting a group of registered survey participants for participation in the survey from the database of registered survey participants;

(d)electronically providing the survey over the network from the central server to the registered survey participants in the group selected, said electronically providing (d)includes at least (d1)forming a survey notification message, the survey notification message indicating that the survey is available to recipients of the survey notification message, (d2)obtaining electronic mail addresses for the registered survey participants in the group selected, and (d3)electronically sending the notification message to the registered survey participants in the group selected at their electronic mail addresses, the survey notification message informs the registered survey participants to obtain and complete the survey by accessing a predetermined world wide web location;

(e)subsequently electronically receiving, at the central server, responses over the network to the survey questions from the registered survey participants in the group selected; and

(f)processing the responses at the central server to determine survey results.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

"Online Market-Research Venture Offers Freebies to Respondents," American Marketplace, January 11, 1996. (Greenfield Online)

Dacko, Scott G, "Data Collection Should Not Be Manual Labor," Marketing News, vol. 29, no. 18, page 31, August 28, 1995.

Alreck, Pamela L. et al., The Survey Research Handbook (2nd ed), Irwin Professional Publishing, page 456, 1995. (Alreck)

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Claims 1 through 23 and 25 through 51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Greenfield Online in view of Dacko and Alreck.

Reference is made to the Examiner's Answer (Paper No. 31, mailed July 30, 2002) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 30, filed June 6, 2002) and Reply Brief (Paper No. 32, filed September 13, 2002) for appellant's arguments thereagainst.

OPINION

As a preliminary matter, we note that appellant has indicated at page 2 of the Brief that the claims do not stand or fall together and that they are argued according to groupings that range from a single claim to all of the claims. As the groupings for various arguments overlap, we will address each argument and the claims appellant lists therefor.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will affirm the obviousness rejection of claims 1 through 23 and 25 through 51.

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Appellant first argues (Brief, pages 4-5 and 16, and Reply Brief, page 3) that claims 49 through 51 recite means plus function elements, with structure described in the specification, which the examiner has ignored. However, appellant fails to specifically point out what elements have been ignored and what structure in the specification corresponds thereto. Therefore, we are not persuaded of any error as to claims 49 through 51.

Next appellant contends (Brief, pages 5-7, and Reply Brief, page 3) that, as to all of the claims, the examiner has provided no evidence that would suggest combining the two references other than hindsight gleaned from appellant's specification. However, as Greenfield Online does not explain how registered participants are notified for private research studies, it would have been obvious to the skilled artisan to select a known method for notifying them. Dacko provides methods of accomplishing notification, specifically e-mailing the surveys (to the registered e-mail addresses) or e-mailing (to the registered e-mail addresses) notification to access a particular (Internet) address that contains the survey. Thus, the motivation for combining is in the references themselves and not from a hindsight analysis.

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Appellant also asserts (Brief, page 6) that Dacko "teaches against anything not expressed therein as to data collection techniques available to market researchers." However, not mentioning a particular method does not constitute a teaching away from such. Further, appellant argues (Brief, pages 6-7) that Dacko fails to teach or suggest Internet or on-line surveys. In response we direct appellant's attention to the second method given in Dacko's seventh method of computerized data collection. In particular Dacko states (in paragraph 9), "Alternatively, using interactive e-mail, researchers can send potential respondents e-mail prompting them to access an address that contains an interactive survey." To what, other than an Internet address, could such "address" refer? Accordingly, we find appellant's arguments regarding motivation to combine unpersuasive.

As to claims 1 through 23, 25 through 37, and 48 through 51, appellant (Brief, pages 7-8 and 11) directs our attention to the survey notification message recited in one form or another in each of independent claims 1, 10, 17, 28, and 49. Appellant questions (Brief, page 9) whether

the single (four sentence) paragraph of . . . [Dacko]
really teach enough such that what is admittedly
patentable over . . . [Greenfield Online] magically

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becomes unpatentable? Just because a survey participant would have to at some point be aware of a survey does not mean that the operation (d) and its various sub-operations are obvious to those skilled in the art.

Appellant further argues (Brief, page 9) that Dacko fails to suggest using the claimed survey notification message to inform registered participants within a selected group to obtain and complete a survey by accessing a predetermined website. Instead, appellant asserts, Dacko pertains only to e-mail surveys, not to Internet surveys.

First, we note that the length of the disclosure in Dacko is irrelevant to the determination of patentability if the disclosure teaches or suggests the limitations in question. Second, as explained *supra*, Dacko directs certain registered participants to an address where the survey is located, which suggests e-mail notification of an on-line, or Internet, survey. Therefore, to answer appellant's question, Dacko's four sentence paragraph, along with the disclosure of Greenfield Online, does teach enough to render the claimed subject matter unpatentable. Accordingly, appellant's arguments regarding the claimed survey notification message are not convincing.

Appellant continues (Brief, pages 12-13) that none of the references teach or suggest a notification message with a link to a survey web page, as recited in claims 17 through 19, 25 through 27, 31, 33, and 51. Specifically, appellant argues that "[a] link is more than an address. A link (e.g., a hyperlink) provides direct access to the specific survey that has been selected for the recipient to participate in." Although we agree that Dacko does not state that the address in the e-mail is actually a hyperlink to an Internet address, we disagree that appellant's hyperlink provides any more specificity as to where the respondent is to go. Instead the provision of a hyperlink to an Internet address merely makes it easier for the respondent to get to said address by reducing the number of steps to get there. Since a hyperlink to an address is known to make it easier for a respondent to reach the address, it would have been obvious to provide a hyperlink rather than just the address. Therefore, we find that appellant's arguments as to claims 17 through 19, 25 through 27, 31, 33, and 51 are not compelling.

Appellant contends (Brief, pages 13-16) that none of the references teaches or suggests on-line registration of participants as recited in independent claims 1, 10, 17, 28, and 49. Greenfield Online discloses private research studies using

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an exclusive base of respondents who have registered, but fails to disclose how they have registered. However, the point of Greenfield Online is to conduct surveys on-line. Further, Dacko discloses (in paragraphs 21-23):

*Encoding data without transcribing from paper: Computer-assisted data collection methods often enable the interviewer or respondent to encode data directly into a computer data base. Numerous hours of tedious effort can then be eliminated by avoiding transcription from paper surveys.

*Minimizing errors in data: Errors in the data are less likely with computer-assisted data collection considering, for example, the possibility of errors being introduced during manual transcriptions of paper surveys or errors in deciphering illegible interviewer or respondent handwriting.

*Speedier data collection and encoding: Computer-based survey methods can speed the process of gathering data at any or all of five points in the data collection process Clearly, all of these add up to time savings, and potential cost savings.

Since registering potential participants is a form of data collection, it would have been obvious to the skilled artisan that the benefits of on-line surveys would equally apply to on-line registration. Specifically, on-line registration would enable the data to be encoded directly into a computer data base, thereby minimizing the time and errors involved with transcribing. Accordingly, Dacko would have suggested to one of ordinary skill in the art to register the exclusive base of

respondents for Greenfield Online by having the participants complete an on-line registration form. Consequently, we are not persuaded by appellant's arguments regarding on-line registration.

Appellant asserts (Brief, pages 16-17) that the references fail to teach or suggest "that a registering participant could choose to select a particular type of incentive award", as recited in claim 23. However, Greenfield Online asks (in paragraph 1), "How do you recruit cybersurfers to participate in online surveys and focus groups?" The answer is, "Offer them free online hours, electronic 'coupons' good for purchases at the virtual mall, and, **if all else fails**, use the oldest of all come-ons, cash" (emphasis ours). By saying "if all else fails," Greenfield Online suggests giving the potential participants a choice as to the reward for completing the survey. Accordingly, appellant's argument that the references fail to teach selection of an incentive award has not convinced us as to the patentability of claim 23.

Regarding claims 38 through 48, appellant contends (Brief, pages 17-19) that neither reference teaches or suggests how to produce surveys to be filled out over the Internet. Specifically, appellant argues that the following limitation in

claim 38 is lacking from the references: a survey is produced at an Internet-based survey manager based on survey information provided by a survey requestor. We direct appellant's attention to paragraphs 2-6 of Greenfield Online. Greenfield explains (in paragraphs 2, 3, and 5) that they are a market research firm with an "in-house hardware and software system linked to the World Wide Web" and with clients who are marketers with World Wide Web sites. Clearly, Greenfield is an Internet-based survey manager, and the clients are marketers requesting a survey. Furthermore, as Greenfield conducts quantitative and qualitative research, Greenfield produces the surveys. Although, Greenfield does not explicitly state that the survey is produced based on information provided by the client, it would have been obvious to use information provided by the client to assure that the survey best represented the needs of the client. Accordingly, we are not persuaded by appellant's argument.

Appellant (Brief, pages 20-22) argues that none of the references teach or suggest that the survey information used to produce the survey is obtained from on-line interaction between the survey requestor and the Internet-based survey manager, as recited in claims 39 and 45. In particular, appellant contends (Brief, page 21) that the references fail to teach identifying a

target audience for the survey through such on-line interaction. The examiner (Answer, page 26) asserts that "the electronic transmission of information is old and well-known in the art of data communications. Electronic transmission of information reaps the benefits of quick, global communication of data." The examiner, therefore, concludes that it would have been obvious to the skilled artisan for the survey manager to receive the survey information from the requestor via the Internet for quick communication thereof regardless of the respective locations of the survey requestor and the survey manager. Appellant responds (Brief, page 21) that the claims require more than "mere electronic transmission of a survey," and that the examiner has provided no motivation for combining general knowledge with the teachings of the references.

We agree with the examiner that the use of the Internet to transfer information back and forth is known to provide the benefit of quick communication of data. Dacko (in paragraph 23) supports the examiner's assertion by stating that computer-based (i.e., Internet) survey methods speed up the process of gathering and encoding data. In fact, Dacko states that computer-based methods get the answers back to the researcher faster. Similarly, Greenfield Online states (in paragraphs 9 and 10) that

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on-line research allows for in-depth interviews across wide geographic areas without the time and expense of travel. Greenfield Online also states that "research studies that previously took five to 10 business days will now be **designed**, administered and analyzed almost overnight" (emphasis ours), thereby suggesting that the survey is designed over the Internet as well. The skilled artisan would have recognized from the above teachings and suggestions that questions and answers between the survey requestor and the survey manager would go more quickly over the Internet. The level of the skilled artisan should not be underestimated. **See In re Sovish**, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Greenfield Online further teaches (in paragraph 4) using an exclusive base of respondents or a focus group, (in paragraph 3) that their system is linked to the World Wide Web, and (in paragraph 5) that they expect their customers, the survey requestors, to have World Wide Web sites. Thus, Greenfield suggests the use of the Internet for communicating with their clients and determining a target audience for the survey. Although Greenfield Online does not explicitly state that the target audience is identified on-line, as Greenfield and Dacko both suggest the use of the Internet for other communications, it

would have been obvious to the skilled artisan to identify the target audience on-line as well. Accordingly, the references do suggest to the skilled artisan that the survey information used to produce the survey is obtained from, and a target audience for the survey is identified by, on-line interaction between the survey requestor and the Internet-based survey manager, as recited in claims 39 and 45.

Regarding claim 43, appellant argues (Brief, pages 22-23) that the examiner used hindsight, rather than any teachings from the references, for generating a survey report and making it available on-line via the Internet-based manager. Greenfield Online explains (in paragraph 10) that research studies that previously took a week or two can now be "designed, administered and **analyzed** almost overnight **and ready for the weekly marketing meeting**" (emphasis ours). Thus, Greenfield Online analyzes the data on-line and apparently forms some sort of report for the weekly meeting. Similarly, Dacko (in paragraph 23) mentions that computer-based survey methods allow for encoding the data into a computer data base. Although neither discusses making the report available on-line, appellant admits (Brief, page 23) that "global access to survey results has been available for many year [sic] through postal mail or electronic mail." Thus, the issue is

whether it would have been obvious to instead provide access to the report on-line. We agree with the examiner that it would have been obvious. The report is rendered on-line (according to Greenfield Online). Further, Greenfield Online and Dacko teach that data transmission is faster and more accurate on-line, since there is no transcription and no mail time. Consequently, if one wanted to make the computerized report available to the public, the teachings of Greenfield Online and Dacko would have suggested to the skilled artisan that the quickest and most accurate way to do so would be on-line. Therefore, we are not persuaded by appellant's arguments.

Appellant argues (Brief, pages 23-25) that none of the references teach or suggest the selection of one or more participant categories for a target audience, as recited in claims 40 and 46. However, Greenfield Online refers (in paragraph 4) to focus groups. Focus groups are, by definition, groups of people that have certain characteristics in common, or, rather, that fall into certain participant categories. Therefore, Greenfield Online's focus groups suggest a selection of participant categories to determine the target audience.

Last, appellant contends (Brief, pages 25-27) that the references applied by the examiner are non-enabling. Appellant

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points to the short length of the references relied upon by the examiner and concludes that they are not enabling for utilizing the Internet as claimed, for sending a survey notification message, and for producing a survey on-line. The length of a reference, by itself, does not determine whether or not a reference is enabling. A reference need not explain every detail since it is speaking to those skilled in the art; what is conventional knowledge will be read into the disclosure. If appellant means to suggest that the skilled artisan would not have been able to determine how to use the Internet in the absence of explicit instruction, he has greatly underestimated the level of the skilled artisan. ***See In re Sovish***, 769 F.2d at 743, 226 USPQ at 774. As pointed out above, we have found that the disclosures from the two references do teach or suggest all of the limitations mentioned by appellant. Accordingly, we will sustain the obviousness rejections of all of claims 1 through 23 and 25 through 51.

CONCLUSION

The decision of the examiner rejecting claims 1 through 23 and 25 through 51 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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